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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,189	07/13/2001	Guang-Jong Jason Wei	163.1438US01	3059
23552	7590	06/10/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			PAK, JOHN D	
			ART UNIT	PAPER NUMBER

1616

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,189

Applicant(s)

WEI ET AL.

Examiner

JOHN D PAK

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004 and 01 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12, 15-20, 23-33 and 35-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12, 15-20, 23-33 and 35-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/23/2004 has been entered.

Claims 1-9, 11-12, 15-20, 23-33, 35-47 are pending in this application.

In the Office action of 9/23/2002, a requirement was made under 35 USC 121 to elect a single disclosed species comprising mono or diester dicarboxylates such as monomethyl malonate. That requirement is maintained and repeated herein. In applicant's reply of 1/15/2003, applicant elected with traverse sebacic acid esters and adipic acid esters. In the absence of contrary indication by applicant in this RCE application, the election carries over here. The pending claims will therefore continue to be examined to the extent that they read on the elected subject matter of record, i.e. sebacic acid esters and adipic acid esters.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-12, 17-20, 23-31, 33, 35, 42-46 stand rejected under 35 USC 102(b) as being anticipated by Carr et al. for the reasons of record (see the Office action of 3/26/2003, pages 3-5; and Office action of 11/4/2003, pages 3-4) and for additional reasons given below.

Applicant's amendments and remarks of 2/23/2004 have been given due consideration, but they were deemed unpersuasive.

Applicants' arguments rely on the fact that all independent claims have been amended to recite a feature wherein the composition is "free of added strong inorganic acid" and/or the method requires "avoiding any addition of strong inorganic acid." However, a close reading of Carr et al. (WO 98/28267) shows explicit selection of an organic acid, thereby being free of added strong inorganic acid. In Examples 17-20 on page 18, Carr et al. selected MSA, i.e. methyl sulfonic acid, and p-TSA, i.e. p-toluenesulfonic acid, as the acid catalyst. Note, Examples 17-20 contain, inter alia, hydrogen peroxide and adipic acid (see p. 17, lines 15-16 ("DBE" contains adipic acid)). No strong inorganic acid was added, and hence, any and all strong inorganic acid was avoided.

Therefore, for the reasons of record and for the reasons further clarified herein, Carr et al. explicitly disclose the dicarboxylate ester compounds under examination here, in combination with hydrogen peroxide, free of added strong inorganic acid, wherein all additional claim-recited features are explicitly met for the reasons fully set forth in the previous Office actions. Specific examples are provided by Carr et al. wherein there is no added strong inorganic acid. That, taken with the reasons of record, is sufficient disclosure for anticipation. The holding and reasoning in In re Sivaramakrishnan, 213 USPQ 441 (CCPA 1982), are applicable here, because explicit disclosure of a necessary species, organic acid (which by necessity means that inorganic acid is not selected, and thus is "free of added strong inorganic acid") satisfies the anticipation requirement for a disclosure. Id. at 442. The claims thereby remain rejected as being anticipated.

Claims 1-9, 11-12, 15-20, 23-33, 35-47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Carr et al. in view of Hei, Chemical Abstracts 134:97683 and Richter et al. for the reasons of record (see the Office action of 3/26/2003, pages 6-7; and Office action of 11/4/2003, pages 4-7) and for additional reasons given below.

Applicant's amendments and remarks of 2/23/2004 have been given due consideration, but they were deemed unpersuasive.

Applicant's arguments about percentages and activity recited in the claims have already been fully responded to in the Office action of 11/4/2003, pages 4-6, which reasons are incorporated herein by reference.

Applicants' further arguments rely on the fact that all independent claims have been amended to recite a feature wherein the composition is "free of added strong inorganic acid" and/or the method requires "avoiding any addition of strong inorganic acid." However, a close reading of Carr et al. (WO 98/28267) shows explicit selection of an organic acid, thereby being free of added strong inorganic acid. In Examples 17-20 on page 18, Carr et al. selected MSA, i.e. methyl sulfonic acid, and p-TSA, i.e. p-toluenesulfonic acid, as the acid catalyst. Note, Examples 17-20 contain, inter alia, hydrogen peroxide and adipic acid (see p. 17, lines 15-16 ("DBE" contains adipic acid)). No strong inorganic acid was added, and hence, any and all strong inorganic acid was avoided.

Therefore, for the reasons of record and for the reasons further clarified herein, Carr et al. explicitly disclose the dicarboxylate ester compounds under examination here, in combination with hydrogen peroxide, free of added strong inorganic acid, wherein all additional claim-recited features are explicitly met and/or suggested for the reasons fully set forth in the previous Office actions. Specific examples are provided by Carr et al. wherein there is no added strong inorganic acid.

For these reasons and for the reasons of record, which are incorporate herein by reference, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made. Carr et al. provide the expectation that their composition, which is directly readable on applicant's composition, would possess superior activity, as claimed (see the discussion of expected activity in the Office action of 11/4/2003, page 3, first full paragraph to page 7, second full

paragraph). One log reduction is not a demanding test, and such level of activity would have been expected for compositions that contain the quantity of hydrogen peroxide and peroxyacids present in the instant claims.

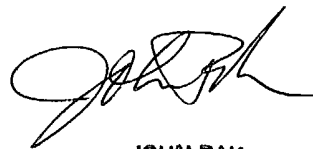
Consequently, all claims must be rejected again. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620, effective February 3, 2004**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Thurman Page, can be reached on (571)272-0602, effective February 3, 2004.

The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.



JOHN PAK
PRIMARY EXAMINER
GROUP 1600